

REMARKS

Pursuant to previous amendments, the pending claims are 16 and 18-21. The Office has rejected the claims as follows: claim 16 is rejected under 35 USC 103(a) over Shkedy in view of Abecassis and further in view of Sullivan et al.; claims 18-21 are rejected under 35 USC 103(a) over Shkedy in view of Abecassis and Sullivan et al. and further in view of Hoffman. The Office has further required that the specification be amended to include the language of claims 18, 19 and 21.

For the following reasons, the undersigned representative respectfully traverses the rejections as set forth below.

Amendments to the Specification

Per the Office's request, the undersigned has amended the specification to include the language of claims 18, 19 and 21. The undersigned notes that these limitations were in claims 18, 19 and 21 as originally filed and thus adequate written description was already provided and these amendments to the specification do not constitute new matter.

Rejection of Claim 16 Over Shkedy in View of Abecassis and Sullivan et al.

With respect to claim 16, neither Shkedy nor Abecassis teach or suggest the following language: "comparing the final bid amount to a pre-determined threshold amount to determine a preferred payment process" The undersigned respectfully disagrees with the Office's citations of Sullivan as analogous art for the reasons stated in the undersigned's previous response. As discussed in MPEP Sec. 2141.01(a), "In order

to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Office argues that Sullivan is pertinent to solving the problem to which the comparison step of claim 16 is directed.

The undersigned fails to see how calculating an amount due pursuant to the terms of a promotion has anything to do with the limitation set forth above which is directed to comparing a final bid amount in an on-line auction to a predetermined amount in order to determine how to process the payment. Importantly, in the language of claim 16, the amount has already been calculated, it is how this amount is to be transferred from the buyer to seller that is being determined based on the comparison step. This is not taught or suggested by Sullivan.

Accordingly, the undersigned submits that Sullivan is not analogous art and further that Sullivan does not teach or suggest the "comparing" limitation as suggested by the Office. The undersigned respectfully submits that claim 16 is allowable over the cited references.

Rejection of Claim 18-21 Over Shkedy in View of Sullivan et al. and Abecassis and further in View of Hoffman

With respect to claims 18-21, each claim includes, *inter alia*, specific limitations for facilitating settlement between the buyer and the seller. As stated above with respect to claim 16, Shkedy, Abecassis and Sullivan fail to teach or suggest the combination of limitations recited in claims 18-21. In addition to those limitations recited with respect to

claim 16, claims 18-21 include additional time periods and actions for facilitating settlement, e.g., "setting a third time period within which the buyer either (iii) returns the good to the seller or (iv) requests a bargaining session with the seller when the buyer determines that the good is non-conforming," also not taught or suggested by Shkedy. Finally, claims 20 and 21 specifically claim, *inter alia*, the process for facilitating settlement when a buyer bid is below the threshold value requested by the seller. Again, Shkedy does not teach or suggest this process.

Further, the Office cites Hoffman (Pub. No. 20010039529) to cure the deficiencies of Shkedy, Sullivan and Abecassis. The undersigned argued in the previous Office Action that Hoffman did not qualify as prior art as it was filed on January 7, 2000 (Provisional filing) and January 5, 2001 (Utility filing), some 6 months AFTER the filing date of the present application July 9, 1999 (Provisional filing) and July 7, 2000 (Utility filing) and was published November 8, 2001, some 16 months AFTER the filing date of the present application. The Office argues that Hamilton does in fact qualify as prior art because claims 16 and 18-21 of the present application do not find 35 USC 112 support in the July 9, 1999 Provisional filing and thus Hamilton's January 7, 2000 Provisional filing date is prior to the effective filing date of the claimed subject matter (July 7, 2000). The undersigned has reviewed the Hamilton Provisional filing and does not find 35 USC 112 support for the portions of the Hamilton reference that are cited by the Office as teaching the claimed limitations. Accordingly, Hamilton does not qualify as prior art since the effective filing date for the description cited by the Office is January 5, 2001 --- 6 months AFTER the effective filing date for the subject matter of claims 16 and 18-21.

The undersigned respectfully submits that claims 18-21 are allowable over the cited references.

CONCLUSION

The undersigned representative respectfully submits that the claims presented herein are in condition for allowance in view of the cited prior art and earnestly request a notice of allowance to that effect. Should there be any further issues regarding prosecution of this case, please do not hesitate to contact the undersigned at the number provided below.

Respectfully submitted,

Date: 1/11/06

/Dawn-Marie Bey Reg. No. 44,442/

Dawn-Marie Bey
Registration No. 44,442

KILPATRICK STOCKTON LLP
607 14th Street
Suite 900
Washington DC 20005
(202) 508-5800

DMB/9009168v.1/191850